IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	10/786,709	Confirmation No.	3646
Applicant	:	Richard F. Dean		
Filed	:	February 24, 2004		
Art Unit	:	2618		
Examiner	:	Dominic E. Rego		
Docket No.	:	020505		
Customer No.	:	23696		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF CONFERENCE REQUEST

Dear Sir:

Further to the concurrent filing of the attached Notice of Appeal, and responsive to the Final Office Action issued on May 6, 2010, the following remarks are submitted in connection with the above-identified patent application under the Pre-Appeal Brief Review program. Appellant expressly maintains the reasons from the prior responses to clearly indicate on the record that Appellant has not conceded any of the previous positions relative to the maintained rejections. Claims 1, 3-10, and 12-22 are pending in the current application, with claims 1, 3-10 and 12-21 allowed.

MATERIAL UNDER REVIEW

Review is requested for the rejection of claim 22 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

The Rejection of Claim 22 under 35 U.S.C. §101

The Office action alleges that the term "A machine-readable storage medium" in claim 22 may read on a wireless channel. However, the claim construction in the Office Action is clearly erroneous. Additionally, because the claimed "machine-readable storage medium" belongs to at least one statutory class, the rejection under 35 U.S.C. §101 is improper.

The Board of Patent Appeals and Interferences Has Previously Determined that a Storage Medium is a Manufacture

In Assignee's Response to Final Office Action submitted on July 6, 2010 ("the Response to Final Office Action"), Assignee showed that the term "storage" in the current specification is consistent with the plain meaning of the term (please see pages 3-4 of the Response to Final Office Action). At page 5 of the Response to Final Office Action, Assignee further argued that storage media are at least a manufacture, noting that the "storage medium" claims were not even an issue in In Re Nuijten, (500 F.3d 1346, Fed. Cir. 2007), which is cited as authority for the rejection of Claim 22. Assignee would like to draw the Examiner's attention to the Board of Patent Appeals and Interferences decision that preceded the Federal Circuit appeal. There, the Board of Patent Appeals and Interferences ruled that Nuijten's claim 15, directed to a "storage medium," fell within the statutory class of a manufacture, and was therefore patentable subject matter. Ex parte Nuijten, (2006 Pat. App. LEXIS 50, *16-17, Board of Patent Appeals and Interferences, 2006). If the rejection of Claim 22 is maintained, Assignee respectfully requests the reasons for the different outcome in the current case be outlined in detail.

The Final Action and Advisory Action Fails to Properly Construe the Term "Storage"

In the Response to Final Office Action, Assignee supplied an applicable definition of the term "storage," and at page 4 requested an alternate definition if the Examiner disagreed with

Assignee's submission. Rather than provide an alternate definition, the Examiner stated that "Further, the wireless channel has the capability of temporarily storing the data during the transmission," without any supporting authority (please see page 3 of the Advisory Action dated July 27, 2010, "the Advisory Action"). The undersigned submits that the Examiner's unsupported construction of the word "storage" as embracing wireless signals propagating at the speed of light is unreasonable. Assignee again requests that if the Examiner continues to allege that a wireless channel is capable of storing instruction(s) and/or data, supporting documentation be provided in a subsequent action.

The Advisory Action Continues to Improperly Reject Claim 22 using the Definition of Machine Readable Medium in Applicant's Specification Without Consideration of the Meaning of the Word "Storage"

The Advisory Action also states "The Examiner respectfully disagrees with Applicant because a wireless channel has the capability of CARRYING instructions." However, the current specification defines a "machine readable medium" as media capable of "storing, containing or carrying instruction(s) and/or data." (Please see the Response to Final Office Action, page 4). Claim 22 does not recite a "machine readable medium," it recites a "machine readable storage medium," which is directed to the subset of machine readable media that are capable of storing. Assignee agrees that a wireless channel is capable of carrying instructions, but would like to again draw the Examiner's attention to the fact that the current specification clearly differentiates between "storing" and "carrying." A "machine readable medium" is capable of "storing, containing or carrying," while a "machine readable storage medium" is a medium for "storing."

In view of the above remarks (considered with the previously submitted responses), Appellant requests the Pre-Appeal Brief Review Board to find in favor of Appellants' positions and arrange for withdrawal of the above-noted rejections. If it is believed that any additional

changes would place the application in better condition for allowance, the Pre-Appeal Brief Review Board or the Examiner is invited to contact the undersigned attorney, at the telephone number listed below.

The arguments made above are not intended to be exhaustive, and there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated 9/7/10

By: _____

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